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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,355	02/06/2004	Tatsuki Nogiwa	2004-0179A	5037

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EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2822

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

25 6/1

<b>Office Action Summary</b>	<b>Application No.</b> 10/772,355	<b>Applicant(s)</b> NOGIWA ET AL.	
	<b>Examiner</b> David E. Graybill	<b>Art Unit</b> 2822	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 13 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-12, 14-17, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2 pages.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Applicant's election without traverse of the species wherein the first adhesive holding region and the second adhesive holding region are provided in one plane and wherein the second adhesive holding region is confined within the first adhesive holding region, allegedly drawn to claims 1-6, 8, 10-12, 14-17, 25 and 26 in the reply filed on 1-9-6 is acknowledged. However, the indication that claim 8 is drawn to the elected species is incorrect. Specifically, claim 8 is drawn to the species wherein the first adhesive holding region and the second adhesive holding region are differentiated in level.

Claims 7-9 and 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1-9-6.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 25 are rejected under 35 U.S.C. 101 as being non-statutory because they improperly embrace or overlap two different statutory classes of invention, namely, apparatus and process of using the

apparatus, which statutory classes are set forth only in the alternative in 35 U.S.C. 101.

Also claims 17 and 25 are rejected under 35 U.S.C. 112, second paragraph, because they are directed to both an apparatus and a process of using the apparatus. As a result, the scope of the claims cannot be determined. See MPEP 2173.05(p)II.

In the rejections infra, generally, reference labels are recited only for the first recitation of identical claim elements.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims ?? are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Takashige (JP2001210998).

In the English abstract and disclosure, and the drawings, Takashige discloses the following:

A substrate holder for holding a circuit board, comprising: a main body 3; and a holding surface formed on the main body for allowing a circuit board 1 to adhere to the holding surface, wherein the holding surface includes: a first adhesive holding region (upper layer of adhesion material 2

when 2 is "formed in drawing 11 as a laminating of two" layers) for holding the circuit board with a first tackiness; and a second adhesive holding region (lower layer of adhesion material 2 when 2 is "formed in drawing 11 as a laminating of two" layers) for holding the circuit board with a second tackiness which is different from the first tackiness, such that the first and second adhesive holding regions hold the circuit board in cooperation; an adhesive material 2 provided on the main body, wherein the first adhesive holding region and the second adhesive holding region are on a surface of the adhesive material; wherein the first adhesive holding region and the second adhesive holding region are within one area of the adhesive material provided on the main body; wherein, the first adhesive holding region and the second adhesive holding region are composed of the same adhesive material "silicone rubber", and the first adhesive holding region and the second adhesive holding region are imparted with different surface undulation characteristics; wherein the first adhesive holding region and the second adhesive holding region have different surface coarsenesses; wherein the first adhesive holding region and the second adhesive holding region inherently are provided within one plane; wherein the first tackiness is less than the second tackiness, and the second adhesive holding region is confined within the first adhesive holding region; wherein the holding surface includes a plurality of sets of the first adhesive holding region and

the second adhesive holding region; the substrate holder according to claim 1 being used as a pallet for carrying the circuit board; wherein the adhesive material is "silicone rubber," polyurethane rubber, or fluorine rubber.

A substrate holder for holding a flexible circuit board, comprising: a main body; and an adhesive material formed on the main body for allowing a circuit board to adhere to the adhesive material, wherein an undulating pattern 6 for tackiness adjustment is provided on a surface of the adhesive material; wherein the adhesive material is silicone rubber, polyurethane rubber, or fluorine rubber; the substrate holder according to claim 15 being used as a pallet for carrying the circuit board.

To further clarify, Takashige discloses wherein the first adhesive holding region and the second adhesive holding region inherently are provided within one plane because the first adhesive holding region inherently comprises one geometric point and the second adhesive holding region inherently comprises another geometric point and the points inherently are provided within one two-dimensional locus of points of such nature that a straight line joining the region's points lies wholly in the two-dimensional locus of points. For example, the first adhesive holding region and the second adhesive holding region inherently are provided within one plane perpendicular to the plane of the intersection of the first adhesive holding region and the second adhesive holding region.

Although Takashige does not appear to explicitly disclose the process limitations, "a through hole for receiving a pin is provided in the first adhesive holding region" and, "an air outlet is provided in the second adhesive holding region," these process limitations do not structurally limit the product of Takashige, and the product of Takashige could be made by the processes. To further clarify, the processes do not limit the product to any particular structure such as a through hole in the first adhesive holding region or an air outlet in the second adhesive holding region because the processes may merely provide intermediate structure which is not necessarily present in the final product. For example, the transitional claim language "comprising" is inclusive of additional process steps such as a process of removing the through hole and air outlet so that the through hole and air outlet are not present in the claimed product and the product of Takashige.

Also, although Takashige does not appear to explicitly disclose the limitations, "a through hole for receiving a pin is provided in the first adhesive holding region, the pin being used when peeling off the circuit board," the language "for receiving a pin" and, "the pin being used when peeling off the circuit board" are statements of intended use of the hole and the pin that do not appear to result in a structural difference between the claimed product and the product of Takashige. Further, because the product

of Takashige appears to have the same structure as the claimed product, it appears to be inherently capable of being used for the intended use, and the statement of intended use does not patentably distinguish the claimed hole from the hole of the intermediate product of Takashige. The manner in which a product operates is not germane to the issue of patentability of the product; *Ex parte Wikdahl* 10 USPQ 2d 1546, 1548 (BPAI 1989); *Ex parte McCullough* 7 USPQ 2d 1889, 1891 (BPAI 1988); *In re Finsterwalder* 168 USPQ 530 (CCPA 1971); *In re Casey* 152 USPQ 235, 238 (CCPA 1967). Also, "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim."; *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). And, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims."; *In re Young*, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)). And, claims directed to product must be distinguished from the prior art in terms of structure rather than function. *In re Danley*, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does [or is intended to do]." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). To further clarify, because the intended use limitation, "for receiving a pin" does not limit the product to a pin, the intended use of the pin, "being used when peeling off the circuit



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board” does not limit the product to a pin being used when peeling off the circuit board.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasa (JP2000261193) and Nishikawa (JP7074497).

In the English abstracts and disclosure, and the drawings, Iwasa discloses a substrate holder for holding a circuit board, comprising: a main body 2; and a holding surface formed on the main body for allowing a circuit

board 1 to adhere to the holding surface, wherein the holding surface includes: a first adhesive holding region 3b for holding the circuit board with a first tackiness; and a second adhesive holding region 3a for holding the circuit board with a second tackiness which is different from the first tackiness, such that the first and second adhesive holding regions hold the circuit board in cooperation; and wherein the first tackiness is less than the second tackiness.

However, Iwasa does not appear to explicitly disclose a through hole for receiving a pin is provided in the first adhesive holding region, the pin being used when peeling off the circuit board; and wherein an air outlet is provided in the second adhesive holding region.

Nevertheless, in the English abstracts and the drawings, Nishikawa discloses a through hole 4 for receiving a pin 5 is provided in the first adhesive holding region 3, the pin being used when peeling off the circuit board 2; and wherein an inherent air outlet 4 is provided in the second adhesive holding region. Moreover, it would have been obvious to combine this disclosure of Nishikawa with the disclosure of Iwasa because it would facilitate provision of the "weakly adhesive base sheet" of Nishikawa and enable efficient removal of the board of Iwasa.

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The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions relevant to the examination of the instant invention.

**For information on the status of this application applicant should check PAIR:**

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.**

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.  
The fax phone number for group 2800 is (571) 273-8300.



David E. Graybill  
Primary Examiner  
Art Unit 2822

D.G.

17-Mar-06